

### **REMARKS**

Claims 1-11 are currently pending in the application. Claim 1 has been amended to more clearly recite, in part, that the first and second dispensing tip containers are "configured to contain a matrix of n x m dispensing tips." Additionally, minor amendments have been made to claim 1 in order to improve the language thereof. Applicants submit that this is not a narrowing amendment as this is only a rewording of the original claim language. Reconsideration of the application is respectfully requested in view of the following remarks.

The Examiner has indicated that "Some" of the priority documents have been received on the face of the PTOL 326. In this regard, Applicants have claimed priority to one foreign priority document. Moreover, Applicants direct the Examiner's attention to the Image File Wrapper (IFW) that includes the single priority document as filed September 25, 2003. Applicants accordingly request that the Examiner acknowledge Applicants claim for foreign priority under 35 U.S.C. § 119 and the filing of the certified copies of the priority documents.

#### ***35 U.S.C. §102 Rejection***

Claims 1-5 and 11 were rejected under 35 U.S.C. §102(b) for being anticipated by U. S. Patent No. 6,006,800 issued to Nakano ("Nakano"). This rejection is respectfully traversed.

For anticipation of a claim under 35 U.S.C. § 102, a single prior art reference must contain each and every limitation of the claim, either expressly or under the doctrine of inherency. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570 (Fed. Circ), *cert. denied*, 488 U.S. 892 (1988).

Applicants submit that Nakano does not disclose or suggest each and every limitation of independent claim 1. Therefore, Nakano does not anticipate the invention recited by claim 1.

Claim 1 sets forth, in part, a microplate liquid handling system comprising a main frame body, a dispensing mechanism including a plurality of cylinders extending side by side and in parallel with each other by an even interval to provide a cylinder array, a moving mechanism supported to the main frame body for moving the dispensing mechanism in X-axis, Y-axis and Z-axis directions, a microplate arranged in the main frame body and having a plurality of wells arranged in an  $n \times m$  matrix, a first dispensing tip container configured to contain a  $n \times m$  matrix of dispensing tips for permitting nozzles to be attached with a first dispensing tip array oriented in the Y-axis, a second dispensing tip container configured to contain a  $n \times m$  matrix of dispensing tips for permitting the nozzles to be attached with a second dispensing array oriented in the X-axis direction, a first reagent vessel storing a reagent to be supplied to the dispensing tips of the cylinder array oriented in the Y-axis direction and a second reagent vessel storing a reagent to be supplied to the dispensing tips of the cylinder array oriented in the X-axis direction.

Nakano is directed to an apparatus for automatic distribution comprising a tip holding rack 2, a reservoir 3, micro plates 4 and 5 and an used tip disposing box 6 which are fixedly arranged on a bottom frame 1a. A pipette unit such as 21 is supported by the side frame portion 1b and includes a plunger 41 fitted into cylinder 35 for movement in a vertical direction. The pipette unit 21 may pick up tips 44 from the tip holding rack 2 in order to distribute liquid with respect to a plurality of wells (4a-4h).

However, claim 1 of the invention recites, in part:

*a first dispensing tip container configured to contain a matrix of  $n \times m$  dispensing tips for permitting the nozzles to be attached with a first dispensing tip array oriented in the Y-axis direction, the first dispensing tip container having a longitudinal axis in parallel with the Y-axis direction;*

*a second dispensing tip container configured to contain a matrix of  $n \times m$  dispensing tips for permitting the nozzles to be attached with a second dispensing tip array oriented in the X-*

*axis direction, the second dispensing tip container having a lateral axis in parallel with the X-axis direction;*

Applicants submit that Nakano does not disclose or suggest a first and a second dispensing tip container each configured to contain a matrix of  $n \times m$  dispensing tips. The Examiner seems to consider the dispensing box 6 of Nakano as corresponding to the “second dispensing tip container” of the claimed invention which is not accurate. The disposing box 6 merely serves as a box for collecting used tips 44. The disposing box 6 does not provide a structure configured to contain a matrix of  $n \times m$  dispensing tips.

For example, the first dispensing tip container is configured to contain a  $n \times m$  matrix of dispensing tips for permitting the nozzles to be attached with a first dispensing tip array oriented in the Y-axis, while the second dispensing tip container is configured to contain a matrix of  $n \times m$  dispensing tips for permitting the nozzles to be attached with a second dispensing tip array oriented in the X-axis direction. Neither Nakano, nor any other reference of record, discloses or suggests these features. For example, Nakano only discloses one tip holding rack. Therefore, Applicants submit that the 102 rejections over claim 1 should be withdrawn for at least this reason, and that claim 1 is allowable over Nakano and the prior art of record. Claims 2-5 and 11 are allowable over Nakano for the same reasons as independent claim 1, from which they depend, as well as for their added features.

### ***35 U.S.C. §103 Rejections***

#### **Nakano in view of Marouiss**

Claims 6-8 were rejected under 35 U.S.C. §103(a) for being unpatentable over Nakano in view of U. S. Patent Publication No. 20010048899 to Marouiss (“Marouiss”). This rejection is respectfully traversed.

Marouiss discloses an integrated sample processing system but does not disclose first and second tip containers. Therefore, Marouiss does not overcome the shortcomings of Nakano. Accordingly, independent claim 1 is allowable over Nakano

or Marouiss, either alone or in combination. Accordingly, claims 6-8 are allowable at least for the reasons discussed above with respect to independent claim 1, from which they depend as well as for their added features.

Nakano in view of Hilson

Claims 9 and 10 were rejected under 35 U.S.C. §103(a) for being unpatentable over Nakano in view of U. S. Patent Publication No. 20030032191 to Hilson (“Hilson”). This rejection is respectfully traversed.

Hilson also fails to overcome the shortcomings of Nakano and Marouiss. In this regard, independent claim 1 is allowable over Nakano or Hilson, either alone or in combination. Accordingly, claims 9-10 are allowable at least for the reasons discussed above with respect to independent claim 1, from which they depend as well as for their added features.

**Provisional Double Patenting Rejection**

Claims 1, 3-8, and 11 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 11 and 12 of copending patent application no. 10/669,796.

Applicants traverse the obviousness-type double patent rejection, nevertheless in order expedite prosecution of the application, Applicants have cancelled claims 11 and 12 of the copending patent application no. 10/669,796. Applicants submit that since claims 11 and 12 are cancelled, the provisional double patenting rejection is no longer proper and that the provisional double patenting rejection has been rendered moot and should be withdrawn.

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Serial No.: 10/669,810

### CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicant hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 23-1951.

Respectfully submitted,



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